

Attachment to Interview Summary

THE LAW FIRM OF
LEE, HONG, DEGERMAN, KANG & SCHMADEKA
A PROFESSIONAL CORPORATION
660 SOUTH FIGUEROA STREET
SUITE 2300
LOS ANGELES, CALIFORNIA 90017
TELEPHONE: (213) 623-2221
FACSIMILE: (213) 623-2211 / (213) 623-8601

FACSIMILE TRANSMISSION

TO: **Examiner Benjamin A. Ailes**
Art Unit 2142

FAX NO.: **571-273-3899**

FROM: Richard C. Salfelder, Esq., Reg. No. 51,127

RE: Serial No.: 09/844,821
Filing Date: April 27, 2001
Our Ref. No.: 2080-3-18
Confirmation No.: 3336

DATE: April 2, 2008

TOTAL PAGES: **18** (including this page)

=====

For discussion during an interview scheduled for April 3, 2008.

Please **acknowledge** safe receipt of this fax by RETURN fax to us. Thank you.

CONFIDENTIALITY NOTE: The information contained in this FAX transmission is intended only for the use of the individual or entity to which it is addressed and may contain information that is privileged, confidential or exempt from disclosure under applicable Federal or State Law. If the reader of this transmission is not the intended recipient or the employee or agent responsible for delivering the message to the intended recipient, you are hereby notified that any dissemination, distribution or copying of this transmission is strictly prohibited. If you receive this transmission in error, please notify us immediately by telephone at (213) 623-2221. Thank you.

Attachment to Interview Summary

Customer No. 035884

Attorney Docket No. 2080-3-18

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:
Doo Sang Park

Art Unit: 2142

Serial No: 09/844,821

Filed: April 27, 2001

Examiner: Ailes, Benjamin A.

For: INFORMATION DISPLAY APPARATUS AND
DISPLAY METHOD OF THE SAME

Conf. No.: 3336

**PROPOSED RESPONSE TO OFFICE ACTION FOR
INTERVIEW DISCUSSION**Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This paper is in response to the Office Action dated December 11, 2007 in connection with the above-identified application, and intended to provide topics for discussion in an interview scheduled for April 3, 2008:

Attachment to Interview Summary

IN THE SPECIFICATION

Please insert the following paragraph before the paragraph titled BACKGROUND OF THE INVENTION on page 1:

CROSS-REFERENCE TO RELATED APPLICATIONS

Pursuant to 35 U.S.C. § 119(a), this application claims the benefit of earlier filing date and right of priority to Korean Application No. 22809/2000, filed on April 28, 2000, the contents of which are hereby incorporated by reference herein in their entirety.

Attachment to Interview Summary**IN THE CLAIMS**

Please amend claims 1, 3-5, 7, 8, 10, 12-14, 16, 17, and 20-22 and cancel claims 6 and 15 as follows:

1. (Currently amended) An information display system, comprising:

a gateway system for converting protocols of an external network and a local network for information exchange between the external network and local network;
a plurality of terminals having a display unit and connected to the local network wherein each of the plurality of terminals exchanges call setup information with the gateway system; and

an information server for:

receiving and storing information transmitted from the external network or local network[.];

determining a call status of each of the plurality of terminals based on call status information included in the call setup information exchanged between each of the plurality of terminals and the gateway system[.]; and

transmitting the stored information to each of the plurality of terminals during an on-hook status after determining the on-hook status[.] of each of the plurality of terminals and

~~displaying the stored information on a display unit of each of the plurality of terminals that is in the on-hook status,~~

wherein each of the plurality of terminals that is in the on-hook status displays the information transmitted from the information server on the display unit and the displayed information is at least one of an advertisement, a guide and a bulletin.

2. (Previously presented) The system of claim 1, wherein each of the plurality of terminals is one of a PC phone and an Internet phone using Internet protocols for data communication.

3. (Currently amended) The system of claim 1, wherein each of the plurality of terminals includes a memory means for temporarily storing information transmitted from

Attachment to Interview Summary

the information server during the on-hook status and a control means for controlling [[the]] storing of the transmitted information in the memory means such that the information stored in the memory means is displayed on the display unit when the on-hook status is detected and voice communication-related information is displayed on the display unit when an off-hook status is detected.

4. (Currently amended) The system of claim 3, wherein the control means in each of the plurality of terminals determines [[a]] the call status of the terminal.

5. (Currently amended) The system of claim 4, wherein the call status is one of [[an]] the on-hook status and [[an]] the off-hook status.

6. (Canceled) ~~The system of claim 3, wherein each of the plurality of terminals includes a display means for displaying information stored in the memory means.~~

7. (Currently amended) The system of claim 1, wherein the information server ~~includes~~ comprises a memory means for storing information transmitted from the external network and a control means for determining the ~~respective~~ call status of each of the plurality of terminals.

8. (Currently amended) The system of claim 7, wherein the control means of the information server transmits the information stored in the memory means of the information server to each of the plurality of terminals during [[an]] the on-hook status of each of the plurality of terminals.

9. (Previously presented) The system of claim 7, wherein the control means of the information server updates contents of the memory means of the information server when new information is received.

Attachment to Interview Summary

10. (Currently amended) An information display system, comprising:
a plurality of terminals having a display unit and connected to a local network;
and
an information system for:
converting protocols of an external network and the local network for
information exchange between the external and local networks[.];
storing various information transmitted from the external network or local
network[.];
determining a call status of each of the plurality of terminals based on call
status information included in call setup information transmitted from each of the
plurality of terminals[.]; and
transmitting the stored information to each of the plurality of terminals
during an on-hook status, and
displaying ~~the information on a display unit of each of the plurality of
terminals that is in the on-hook status,~~
wherein each of the plurality of terminals that is in the on-hook status displays the
information transmitted from the information system on the display unit and the
displayed information is at least one of an advertisement, a guide and a bulletin.

11. (Previously presented) The system of claim 10, wherein each of the plurality
of terminals is one of a PC phone and an Internet phone using Internet protocols.

12. (Currently amended) The system of claim 10, wherein each of the plurality of
terminals includes a memory means for storing information transmitted from the
information system and a control means for controlling [[the]] storing of the transmitted
information in the memory means such that the information stored in the memory
means is displayed on the display unit when the on-hook status is detected and voice
communication-related information is displayed on the display unit when an off-hook
status is detected.

Attachment to Interview Summary

13. (Currently amended) The system of claim 12, wherein the control means of each of the plurality of terminals determines ~~[[a]]~~ the call status of the terminal.

14. (Currently amended) The system of claim 13, wherein the call status is one of ~~[[an]]~~ the on-hook status and ~~[[an]]~~ the off-hook status.

15. (Canceled) ~~The system of claim 10, wherein each of the plurality of terminals includes a display means for displaying information stored in a memory means of the terminal.~~

16. (Currently amended) The system of claim 10, wherein the information system ~~includes-comprises~~ a memory means for storing the information transmitted from the external network and a control means for determining ~~[[a]]~~ the call status of each of the plurality of terminals.

17. (Currently amended) The system of claim 16, wherein the control means of the information system transmits the information stored in the memory means of the information system to each of the plurality of terminals during ~~[[an]]~~ the on-hook status of each of the plurality of terminals.

18. (Previously presented) The system of claim 16, wherein the control means of the information system updates contents of the memory means of the information system when new information is received.

19. (Previously presented) An information display method, comprising:
storing information transmitted from an external network or a local network;
transmitting the stored information to a plurality of terminals connected to the local network during an on-hook status of each of the plurality of terminals after determining a call status of each of the plurality of terminals based on call status

Attachment to Interview Summary

information included in call setup information transmitted from each of the plurality of terminals; and

displaying the transmitted information on a display unit of each of the plurality of terminals that is in the on-hook status,

wherein the information is stored regardless of a telephone call and the displayed information is at least one of an advertisement, a guide and a bulletin.

20. (Currently amended) The method of claim 19, wherein the stored information is transmitted to each of the plurality of terminals based on [[a]] the call status of a pre-selected one of the plurality of terminals.

21. (Currently amended) The method of claim 19, wherein displaying the transmitted information comprises:

storing the received information at each of the plurality of terminals;

determining the call status of each of the plurality of terminals; and

displaying the stored information on each of the plurality of terminals during [[an]] the on-hook status.

22. (Currently amended) The method of claim 21, further comprising:
ceasing ~~the display of~~ displaying the stored information and displaying voice communication-related information on [[any]] at least one of the plurality of terminals that assumes an off-hook status; and

re-displaying the stored information when the ~~terminal again assumes an~~ at least one of the plurality of terminals resumes the on-hook status.

Attachment to Interview Summary**REMARKS**

Applicant has considered and studied the Office Action dated December 11, 2007. Claims 1-5, 7-14, and 16-22 are pending. Claims 1, 3-5, 7, 8, 10, 12-14, 16, 17, and 20-22 have been amended and claims 6 and 15 have been canceled without prejudice. Claims 1, 10, and 19 are independent claims.

The following are topics for discussion during an interview scheduled for April 3, 2008.

It is submitted that the application is in condition for allowance. Reconsideration and reexamination are respectfully requested.

Amendments to Specification

Amendments have been made to the specification at page 1 in order to indicate the priority claim to the foreign application. Accordingly, no new matter has been added.

Amendments to the Claims

Claims 1, 3-5, 7, 8, 10, 12-14, 16, 17, and 20-22 have been amended to more clearly disclose the invention. It is respectfully submitted that the amendments have support in the application as originally filed.

§ 103 Rejections

Claims 1-22 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Gerszberg et al. ("Gerszberg '881" U.S. Pat. No. 6,359,881) in view of Gerszberg et al. ("Gerszberg '621" U.S. Pat. Appl. No. 2001/0040621). Applicant respectfully traverses the rejection.

It is respectfully noted that the Federal Circuit has provided that an Examiner must establish a case of prima facie obviousness. Otherwise the rejection is incorrect and must be overturned. As the court stated in In re Rijklaart, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993):

Attachment to Interview Summary

"In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. Only if that burden is met, does the burden of coming forward with evidence or argument shift to the applicant. 'A prima facie case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art.' If the examiner fails to establish a prima facie case, the rejection is improper and will be overturned." (citations omitted.)

It is well-settled law that to support a finding of obviousness, a reference must provide some motivation, working without the benefit of the applicant's specification, to make the necessary changes in the device disclosed in the reference. The mere fact that a worker in the art could modify the reference to meet the terms of the claims is not, by itself, sufficient. The mere fact that a reference may be modified in the direction of the claimed invention does not make the modification obvious unless the reference expressly or impliedly teaches or suggests the desirability of the modification. In re Gordon, 221 USPQ 1125, 1127 (Fed. Cir. 1984); Ex parte Clapp, 227 USPQ 972, 973 (Bd. App. 1985); Ex parte Chicago Rawhide Mfg. Co., 223 USPQ 351, 353 (Bd. App. 1984).

It is further respectfully noted that "[a] prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention." MPEP § 2141.02 (emphasis in original).

With this paper, claims 6 and 15 have been canceled without prejudice. It is, therefore, respectfully submitted that the rejection is moot with respect to claims 6 and 15 and it is respectfully requested that the rejection be withdrawn.

First of all, it is respectfully noted that Gerszberg '821 has been cited by the Examiner to cure the deficiencies of Gerszberg '881, which teaches "the transmission of information to the terminal at any point in time" (page 3 of the Office action). Specifically, it is noted that the Examiner cites Gerszberg '621 for teaching "information, advertisements, is transmitted to a videophone when it is determined that the videophone is not in use (p. 5, para. 0042) and therefore the videophone is in an on-hook condition."

Attachment to Interview Summary

However, as was respectfully submitted in the last response dated August 30, 2007, the disclosure of Gerszberg '881 and Gerszberg '621 are contradictory with respect to the display of the advertisement. It is respectfully noted that the Examiner, in the "Response to Arguments" as paragraph 28 of the present Office Action, fails to address the specific remarks that were presented in the previous response. It is respectfully requested that the Examiner respond to the following remarks, which were presented in the previous response:

Furthermore, it is respectfully submitted that even if the videophones disclosed in Gerszberg '881 and Gerszberg '621 may be similar in a way as asserted by the Examiner, there is at least one significant difference between the videophones of Gerszberg '881 and Gerszberg '621, which distinguishes them clearly, and thus, making it impossible to combine these two references to arrive at the presently claimed invention.

As asserted by the Examiner, the videophone of Gerszberg '881 displays the stored information on the display of the terminal when the terminal enters an "on-hook" status. However, it is respectfully noted that the Examiner is silent about the display in the videophone of Gerszberg '621, which displays advertisements on a videophone when the videophone is in use, and therefore, the videophone is in an "off-hook" status when advertisements are displayed, contrary to the videophone of Gerszberg '881, which displays the information in an "on-hook" status. Specifically, Gerszberg '621 discloses systems and methods for displaying video advertisements on a videophone when the videophone is linked to a non-video enabled telephone, i.e., when the videophone is in use for communicating with other phone, but the videophone's display is not in use and the videophone user is near the videophone during a telephone call (p. 1, para. 0009 and p. 4, para. 0039).

Therefore, Gerszberg '621, which discloses a videophone downloading (transmitting) advertisements when the videophone is not being used, i.e., in an "on-hook" status, but displaying advertisements on the videophone when the videophone is in use, i.e., in an "off-hook" status, fails to cure the deficiency of Gerszberg '881, which discloses transmitting information to a videophone at any point, i.e., in both "on-hook"

Attachment to Interview Summary

and "off-hook" status, and displaying advertisement on the videophone whenever the videophone is not in active use, i.e. in an "on-hook" status. Accordingly, in view of the contradicting disclosure of Gerszberg '881 and Gerszberg '621, they fail to be combinable to arrive at the presently claimed invention, wherein the stored information is transmitted to each of a plurality of terminals during an "on-hook" status and displayed on a display unit of each of the plurality of terminals that is in the "on-hook" status.

As asserted by the Examiner at paragraph 30 of the Office action and disclosed at col. 11, ll. 65-66 of Gerszberg '881, "[a]dvertising can be displayed on the video phone, whenever the videophone is not in active use." It is respectfully noted that the videophone of Gerszberg '881 displays the advertisement on the display when the videophone enters an "on-hook" status.

In contrast, it is respectfully noted that the videophone of Gerszberg '621 displays advertisements when the videophone is in use or during "off-hook" status. Specifically, it is noted that paragraph 0009 of Gerszberg '621 discloses "displaying video advertisements on a videophone when the videophone is linked to a non-video-enabled telephone" and "[s]ince some or all of the videophone's display might not be otherwise used, and the videophone user may be near the videophone during a telephone call, the user would be a captive audience to these advertisements."

Therefore, it is respectfully submitted that even if Gerszberg '621 teaches transmitting advertisements to a videophone when the videophone is in an "on-hook" condition, one of ordinary skill in the art would not look to Gerszberg '621 to modify the Gerszberg '881 invention without the benefit of impermissible hindsight based upon the benefit of the applicant's specification since the videophone of Gerszberg '621 is in an "off-hook" status when advertisements are displayed, while the videophone of Gerszberg '881 displays the advertisements in an "on-hook" status. Accordingly, it is further respectfully submitted that Gerszberg '621, which discloses contradictory features for the similar videophone as Gerszberg '881, teaches away from the asserted combination of references and, therefore, the combination of Gerszberg '621 and Gerszberg '881 is improper and cannot be relied upon to disclose or suggest the

Attachment to Interview Summary

information stored in the memory unit is displayed on a display unit of each of the plurality of terminals during the on-hook status, as recited in amended independent claims 1 and 10, and displaying the information temporarily stored at each of the plurality of terminals on a display unit of each of the plurality of terminals during an on-hook status, as recited in amended independent claim 19.

Notwithstanding that the combination of Gerszberg '621 and Gerszberg '881 is improper, it is respectfully submitted that the asserted combination of Gerszberg '881 and Gerszberg '621 still fails to teach the recited determining a call status of each of the plurality of terminals recited in independent claims 1, 10 and 19. It is respectfully noted that the claims recite a specific way in which the determining is performed, specifically based on call status information included in the call setup information exchanged between each of the plurality of terminals and the gateway system in independent claim 1 and based on call status information included in call setup information transmitted from each of the plurality of terminals in independent claims 10 and 19.

It is respectfully noted that the Examiner provides no indication of any teaching in either Gerszberg '881 or Gerszberg '621 the call status is determined based on call status information included in the call setup information exchanged between each of the plurality of terminals and the gateway system or based on call status information included in call setup information transmitted from each of the plurality of terminals. It is respectfully submitted that the cited portions of Gerszberg '881 merely teach the "[a]dvertising can be displayed ... whenever the videophone is not in active use" and the cited portions of Gerszberg '621 merely teach that "advertisements may be downloaded ... when the videophone is not being used."

It is respectfully submitted that the Examiner must be interpreting Gerszberg '881 and Gerszberg '621 as inherently teaching determining a call status of each of the plurality of terminals. It is further respectfully submitted that even if Gerszberg '881 and Gerszberg '621 arguably do teach determining a call status of each of the plurality of terminals, the cited portions cannot be interpreted to inherently teach that the determining is based on call status information included in the call setup information exchanged between each of the plurality of terminals and the gateway system or based

Attachment to Interview Summary

on call status information included in call setup information transmitted from each of the plurality of terminals. Therefore, it is respectfully submitted that the improper combination of Gerszberg '881 and Gerszberg '621 cannot be asserted as teaching determining a call status of each of the plurality of terminals that is based on call status information included in the call setup information exchanged between each of the plurality of terminals and the gateway system, as recited in independent claim 1, or based on call status information included in call setup information transmitted from each of the plurality of terminals, as recited in independent claims 10 and 19.

Notwithstanding that the combination of Gerszberg '621 and Gerszberg '881 is improper, it is respectfully noted that the Examiner asserts, at paragraph 7 of the Office action with respect to claim 3, that col. 8, ll. 44-52 of Gerszberg '881 teaches "the system wherein each of the plurality of terminals includes a memory means for storing information transmitted from the information server," that col. 11, ll. 65-66 of Gerszberg '881 teaches "a control means for controlling the storing of the transmitted information in the memory means such that the information stored in the memory means is displayed when the on-hook status is detected" and that col. 9, ll. 17-27 of Gerszberg '881 teaches "voice communication-related information is displayed when an off-hook status is detected." It is further respectfully noted that the Examiner, at paragraph 26 of the Office Action with regard to claim 22, asserts that col. 9, ll. 17-27 of Gerszberg '881 also teaches "ceasing the display of the stored information."

With regard to col. 8, ll. 44-52 of Gerszberg '881, it is respectfully noted that the disclosure is "store information representing users' preferences and/or the received unicast or multicast information in memory ... for later play" and "for example, **video clips or movies** may be multicast to all customers." (emphasis added). Specifically, it is respectfully noted that col. 8, ll. 44-52 of Gerszberg '881 discloses "multicast broadcast services." Therefore, it is respectfully submitted that col. 8, ll. 44-52 of Gerszberg '881 discloses multicast broadcast services for multicasting video clips or movies, but fails to disclose or suggest that the information stored in the memory unit is at least one of an advertisement, a guide and a bulletin, as recited in amended independent claims 1, 10, and 19.

Attachment to Interview Summary

Furthermore, it is respectfully noted that col. 8, ll. 44-52 of Gerszberg '881 discloses that the multicast information may be immediately viewed in real time or stored in the memory for "later viewing," but fails to disclose or suggest that a memory means for temporarily storing information transmitted from the information server during the on-hook status, as recited in amended claim 3. It is respectfully submitted that Gerszberg '881 discloses that the multicast information is programmed to be stored in the memory by the user's pre-configuration, rather than being stored during the on-hook status. Therefore, it is further respectfully submitted that storing and displaying of the multicast information disclosed in Gerszberg '881 is not the "utilization of passive services" asserted by the Examiner at paragraph 29 of the Office action and, therefore, the col. 8, ll. 44-52 of Gerszberg '881 is not sufficient to disclose a memory means for temporarily storing information transmitted from the information server during the on-hook status, as recited in amended claim 3.

With regard to col. 11, ll. 65-66 of Gerszberg '881, it is respectfully noted that the disclosure is "[a]dvertising can be displayed on the videophone, whenever the videophone is not in active use." It is respectfully submitted that "advertising" disclosed at col. 11, ll. 65-66 of Gerszberg '881 is different from the "multicast information" disclosed at col. 8, ll. 44-52 of Gerszberg '881. Furthermore, it is respectfully submitted that it is well-known in the art that multicast information, such as video clips or movies, is multicast to the customer and displayed on the display in response to the customer's demand because displaying the video clips or movies whenever the videophone is in the "on-hook" status would not make sense unless the customer is viewing the display of the videophone.

Therefore, it is respectfully submitted that the asserted "multicast information, such as video clips or movies" that is disclosed as "stored" at col. 8, ll. 44-52 of Gerszberg '881 and the asserted "information" or "advertising" that is disclosed as "displayed" at col. 11, ll. 65-66 of Gerszberg '881 are not the same. It is further respectfully submitted that the disclosure at col. 11, ll. 65-66 of Gerszberg '881 is not sufficient to disclose or suggest the information stored in the memory means is

Attachment to Interview Summary

displayed on the display unit when the on-hook status is detected, as recited in amended claim 3.

With regard to col. 9, ll. 17-27 of Gerszberg '881 in connection with the rejection of claim 22, it is respectfully noted that the disclosure is "[w]hen the videophone 130 is used as a videophone, the display 141 may include one or more video window(s) 160" and "[t]he display may also include a dialed-telephone-number window 161." It is further respectfully noted that the Examiner has interpreted, at paragraph 26 of the Office action, this disclosure as teaching "ceasing the display of the stored information and displaying voice communication-related information on any of the plurality of terminals that assumes an off-hook status."

As previously respectfully submitted, Gerszberg '621 discloses displaying the advertisement in the "off-hook" status. Therefore, it is again respectfully submitted that the disclosure of Gerszberg '881 and Gerszberg '621 are contradictory with respect to displaying during the "off-hook" status because Gerszberg '881 discloses displaying "voice communication-related information" during the "off-hook" status while Gerszberg '621 discloses displaying the "advertisement" during the "off-hook" status. Therefore, it is respectfully submitted that Gerszberg '621, which discloses displaying "advertisement" in the "off-hook" status, and Gerszberg '881, which discloses displaying "voice communication-related information" during the "off-hook" status, are not combinable to arrive at ceasing displaying the stored information and displaying voice communication-related information on at least one of the plurality of terminals that assumes an off-hook status, as recited in amended claim 22.

As previously respectfully noted, "a prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention." Therefore, it is again respectfully submitted that the combination of Gerszberg '881 and Gerszberg '621 is improper.

For the reasons above, it is respectfully asserted that independent claims 1, 10 and 19 are allowable over the cited combination of references. It is further respectfully asserted that claims 3 and 22 also are allowable over the cited combination of references both by virtue of the limitations recited therein as well as by virtue of their

Attachment to Interview Summary

dependence from an allowable independent claim. Moreover, it is respectfully asserted that claims 2, 4, 5, 7-9, 11-14, 16-18, 20 and 21 also are allowable over the cited combination of references by virtue of their dependence from an allowable independent claim.

Attachment to Interview Summary

CONCLUSION

In view of the above remarks, Applicant submits that claims 1-5, 7-14, and 16-22 of the present application are in condition for allowance. Reexamination and reconsideration of the application, as originally filed, are requested.

If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is requested to call the undersigned attorney at the Los Angeles, California telephone number (213) 623-2221 to discuss the steps necessary for placing the application in condition for allowance.

Respectfully submitted,

Lee, Hong, Degerman, Kang & Schmadeka

Date: DRAFT, 2008

By: _____
Richard C. Salfelder
Registration No. 51,127
Attorney for Applicant

Customer No. 035884